

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Markus John
Ser. No. 79157494
Filed 3/7/2014
Mark: COLORS GRAYS

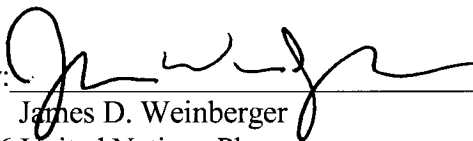
RESPONSE TO BOARD ORDER

Grey Global Group LLC ("GGGL") hereby submits this response to the Board's May 12, 2016 Order regarding its extensions of time to oppose the above-referenced application and its Notice of Opposition, filed with the Board on April 12, 2016 (the "Notice"). The Notice inadvertently and incorrectly listed GGGL's predecessor-in-interest Grey Global Group Inc. as Opposer. As shown in Exhibit A, hereto, on November 7, 2013 Grey Global Group Inc. converted into a Delaware limited liability company and changed its name to GGGL. Pursuant to Fed. R. Civ. P. 15(a)(2), GGGL hereby requests leave to file a First Amended Notice of Opposition, a copy of which is attached as Exhibit B, to permit it correct the formal name of the opposer in the Opposition filed on April 12, 2016. GGGL regrets any inconvenience its error may have caused the Board.

Dated: New York, New York
May 13, 2016

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

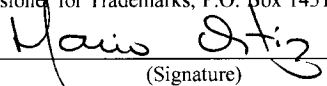
By: 
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New York, New York 10017
Tel: (212) 813-5900
Email: jweinberger@frosszelnick.com

Attorneys for Grey Global Group LLC

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service via Express Mail No. EF 115093647 US in an envelope addressed to the Trademark Trial and Appeal Board, Commission for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on:

5/13/2016
(Date of Deposit)
MARIO ORTIZ
(Printed name of person mailing paper or fee)


(Signature)
5/13/2016
(Date of Signature)



05-13-2016

U.S. Patent & TMO/CTM Mail Rpt Dt. #11

EXHIBIT A

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

ETAS ID: TM308463

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	Corporate conversion and change of name

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
Grey Global Group Inc.		11/07/2013	CORPORATION: DELAWARE

RECEIVING PARTY DATA

Name:	Grey Global Group LLC
Street Address:	200 Fifth Avenue
City:	NEW YORK
State/Country:	NEW YORK
Postal Code:	10010-3372
Entity Type:	LIMITED LIABILITY COMPANY: DELAWARE

PROPERTY NUMBERS Total: 14

Property Type	Number	Word Mark
Registration Number:	4099342	FAMOUSLY EFFECTIVE
Registration Number:	4074228	GRAVY
Registration Number:	4156742	GRAVY TALKS
Registration Number:	1913691	GREY
Registration Number:	2469398	GREY
Registration Number:	2474059	GREY ALLIANCE
Registration Number:	4145602	GREY ALLIANCE
Registration Number:	2548233	GREY GLOBAL GROUP
Registration Number:	0650548	GREY MATTER
Registration Number:	4139300	GREY MATTER
Registration Number:	4454007	GREY MATTERS
Registration Number:	4095737	GREYGROUP
Registration Number:	4353094	GREYWORKS
Registration Number:	3421328	WINGLATINO

CORRESPONDENCE DATA

Fax Number: 2128135901

Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

Phone: 2128135900

Email: assignments@fzlz.com

TRADEMARK

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Correspondent Name:	LAWRENCE E. APOLZON
Address Line 1:	FROSS ZELNICK LEHRMAN & ZISSU, P.C.
Address Line 2:	866 UNITED NATIONS PLAZA
Address Line 4:	NEW YORK, NEW YORK 10017

ATTORNEY DOCKET NUMBER:	GYA 1405055
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NAME OF SUBMITTER:	Lawrence E. Apolzon
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SIGNATURE:	/anca nicolescu/
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DATE SIGNED:	06/23/2014
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Total Attachments: 3

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Delaware

PAGE 1

The First State

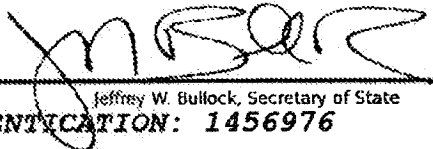
I, JEFFREY W. BULLOCK, SECRETARY OF STATE OF THE STATE OF DELAWARE DO HEREBY CERTIFY THAT THE ATTACHED IS A TRUE AND CORRECT COPY OF THE CERTIFICATE OF CONVERSION OF A DELAWARE CORPORATION UNDER THE NAME OF "GREY GLOBAL GROUP INC." TO A DELAWARE LIMITED LIABILITY COMPANY, CHANGING ITS NAME FROM "GREY GLOBAL GROUP INC." TO "GREY GLOBAL GROUP LLC", FILED IN THIS OFFICE ON THE SEVENTH DAY OF NOVEMBER, A.D. 2013, AT 1:57 O'CLOCK P.M.



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You may verify this certificate
at corp.delaware.gov/authver.shtml


Jeffrey W. Bullock, Secretary of State
AUTHENTICATION: 1456976

DATE: 06-16-14

TRADEMARK
REEL: 005307 FRAME: 0974

CERTIFICATE OF CONVERSION

CONVERTING

GREY GLOBAL GROUP INC.
(a Delaware Corporation)

TO

GREY GLOBAL GROUP LLC
(a Delaware Limited Liability Company)

November 7, 2013

Grey Global Group Inc., the corporation that is converting to a Delaware limited liability company (the "Converting Corporation"), and Grey Global Group LLC, the continuing Delaware limited liability company (the "LLC"), hereby certify that:

1. Name of Converting Corporation. The name of the Converting Corporation immediately prior to the filing of this Certificate of Conversion was "Grey Global Group Inc."

2. Date and Jurisdiction of Organization of Converting Corporation. The date on which, and the jurisdiction where, the Converting Corporation was organized are as follows:

<u>Date</u>	<u>Jurisdiction</u>
September 8, 2004	Delaware

3. Name of Converted Limited Liability Company. The name of the Delaware limited liability company to which the Converting Corporation has been converted and the name set forth in the Certificate of Formation of the Company, filed in accordance with Section 18-214(b) of the Delaware Limited Liability Company Act, is "Grey Global Group LLC".

4. Approval of Conversion. The conversion of the Converting Corporation to the LLC has been approved in accordance with the provisions of Section 266 of the General Corporation Law of the State of Delaware.

5. Effectiveness. This Certificate of Conversion shall become effective on November 7, 2013.

IN WITNESS WHEREOF, the undersigned has duly executed this Certificate of Conversion as of the date first written above.

GREY GLOBAL GROUP INC.

By: _____

Name: Kevin Farewell

Title: Secretary

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GREY GLOBAL GROUP LLC,

Opposer,

v.

JOHN MARKUS,

Applicant.

FIRST AMENDED NOTICE OF OPPOSITION

Opposer, Grey Global Group LLC, a Delaware limited liability corporation with an address at 200 Fifth Avenue, New York, New York 10010-3372, believes that it will be damaged by registration of the mark COLORS GRAYS (and design), App. Ser. No. 79/157,494, published in the Official Gazette on October 20, 2015, and hereby opposes same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is the owner of the trademarks GREY, GREY GLOBAL GROUP, GREYgroup, GREY ALLIANCE, GREYWORKS (collectively, the “GREY Marks”), which it has used in connection with advertising and marketing services and related services, and of all common law rights and associated goodwill in those trademarks. Opposer has continuously used those marks in commerce for those services since at least as early as 1917, April 2000, 2006, September 1, 1996 and March 2012, respectively.
2. The GREY Marks constitute a family of marks.
3. Opposer has invested a substantial amount of time, effort, and money advertising and promoting the GREY Marks. By virtue of the extensive use and promotion of those marks, and the sale and promotion of services under those marks, the GREY Marks have come to be

recognized as identifying services finding their origin exclusively in or otherwise associated with Opposer. Opposer's GREY Marks have become distinctive of Opposer's services, and they represent enormous goodwill of Opposer.

4. Opposer is the owner of the following U.S. federal trademark registrations for the GREY Marks:

- Reg. No. 2,469,398 for the mark GREY in International Class 35 for "house mark of an advertising and marketing communications agency," based on a first use in commerce in 1917.
- Reg. No. 1,913,691 for the mark GREY in International Class 35 for "advertising agency services," based on a first use in commerce in 1917;
- Reg. No. 2,548,233 for the mark GREY GLOBAL GROUP in International Class 35 for "advertising agency services and marketing communications consulting services," based on a first use in commerce in April 2000;
- Reg. No. 4,095,737 for the mark GREYgroup in International Class 35 for "Advertising, marketing, and public relations services," based on a first use in commerce in 2006;
- Reg. No. 4,145,602 for the mark GREY ALLIANCE in International Class 35 for "Advertising, marketing, promotional, and publicity services; advertising, marketing, promotional, and publicity services for the benefit of entertainment and sports-oriented properties; public relations; event planning and management for marketing, branding, promoting or advertising the goods and services of others; promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by

means of sponsorship relationships and product placement,” based on a first use in commerce in September 1, 1996; and

- Reg. No. 4,353,094 for the mark GREYWORKS in International Class 35 for “Advertising services; production of advertising materials, advertising matter and commercials” based on a first use in commerce in March 2012.

(These registrations are referred to collectively as “Opposer’s Registrations.”) Opposer’s Registrations are valid, subsisting, in full force and effect, and are evidence of Opposer’s exclusive rights to use such marks in connection with the services listed pursuant to 15 U.S.C. §§ 1057 and 1115.

5. Upon information and belief, Applicant is a German citizen with an address of Schlossberg 3, 79639 Grenzach-Wyhlen, Federal Republic of Germany.

6. On March 7, 2014, Applicant filed Application Ser. No. 79/157,494 to register the mark COLORS GRAYS (and design) for the following goods and services:

- “Printed materials, namely, books, magazines, journals, posters, postcards, calendars in the field of art; photographs; photo-engravings; photograph stands; paper; cardboard; printers' type; printing blocks” in International Class 16;
- “Clothing items, namely, shirts, pants, jackets, shorts, blouses, pullovers, jeans, coats, underwear, dresses, suits; footwear; headgear, namely, hats, caps, hoods” in International Class 25;
- “Advertising; business management and administration; providing office functions; on-line wholesale store and retail store services featuring works of art; organization and conducting of exhibitions and trade fairs for commercial or advertising purposes; auctioneering; procurement services, namely, purchasing

works of art and works of photographers for others; procurement of contracts for others for the purchase of works of art; compilation and systematization of data into computer databases; dissemination of business prospectuses; distribution and dissemination of advertising matter; art galleries; art gallery services, on-line art galleries” in International Class 35; and

- “Education and entertainment services, namely, classes, seminars, conferences and workshops in the field of art; art exhibition services; publication of books, magazines, journals and electronic publications; artists' services, namely, photography services and painting services” in International Class 41,

pursuant to Section 66A of the Lanham Act, 15 U.S.C. 1141f(a) (the “COLORS GRAY Mark”).

7. The GREY Marks have been registered and used continuously by Opposer since a date long prior to any date on which Applicant can rely.

8. The COLORS GRAY Mark is legally identical to the prior-registered and prior-used GREY Marks in sight, sound and commercial impression.

9. Applicant’s registration of the COLORS GRAY Mark for advertising; business management and administration; providing office functions; organization and conducting of exhibitions and trade fairs for commercial or advertising purposes; compilation and systematization of data into computer databases; dissemination of business prospectuses; distribution and dissemination of advertising matter in International Class 35 (the “Opposed Services”) is likely to create the erroneous impression that Applicant’s services originate from or are otherwise associated with Opposer, or that the COLORS GRAY Mark is endorsed by or in some way connected with Opposer, all to Opposer’s injury and harm.

10. Registration of the COLORS GRAY Mark in connection with the Opposed Services is likely to cause confusion, cause mistake, or to deceive the public into the false belief that such services come from or are otherwise sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. Opposer is and will continue to be damaged by the registration of the COLORS GRAY Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 79/157,494 be denied.

Dated: New York, New York
_____, 2016

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____
James D. Weinberger
866 United Nations Plaza
New York, New York 10017
Tel: (212) 813-5900
Email: jweinberger@frosszelnick.com

Attorneys for Opposer

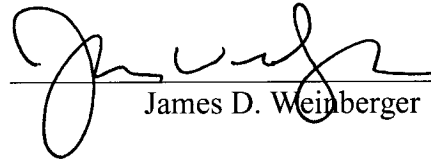
CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the **NOTICE OF OPPOSITION** to be served by prepaid, first-class mail on this __ day of _____, 2016, upon applicant's attorneys, RA Peter Kraus, Freidrichstraße 95, 10117 Berlin GERMANY.

James D. Weinberger

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of this **RESPONSE TO BOARD ORDER** to be served by prepaid, first-class mail on this 13th day of May, 2016, upon applicant's attorneys, RA Peter Kraus, Freidrichstraße 95, 10117 Berlin GERMANY.


James D. Weinberger